

## **REMARKS**

### **I. Introduction**

Claims 1-70 are pending in the present application, but have been rejected by the Current Action as unpatentable under 35 U.S.C. § 103(a). In this Response, the Applicants have amended claim 62 to correct a typographical error, but have added no new matter. This Response also demonstrates that the Examiner's rejections have failed to meet the requirements of the M.P.E.P. in at least three areas. First, the Current Action fails to clearly identify which of the cited references are used to reject which claims. Second, the Current Action fails to properly delineate the arguments supporting the use of any of the cited references. Third, the rejections the Examiner appears to employ do not establish a prima facie case of obviousness under 35 U.S.C. § 103. In light of the arguments contained herein, the Applicants respectfully ask the Examiner to withdraw the rejections contained in the Current Action.

### **II. The Current Action Fails to Detail The Examiner's Intended Rejections**

All of the pending claims appear to be rejected as obvious in light of cited art. M.P.E.P. § 706.02(j), states that "it is important for the examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given a fair opportunity to reply." However, because the Current Action fails to clearly identify which of the cited references the Examiner has used to reject which claims, the Applicants respectfully assert that they can have not been given a fair opportunity to reply.

The Current Action initially states that the pending claims are unpatentable over a combination of Katz et al., U.S. Patent No. 6,424,706 (hereinafter *Katz*), Osmani et al., U.S. Patent No. 5,815,807 (hereinafter *Osmani*), and Morgan, U.S. Patent No. 6,064,875 (hereinafter *Morgan*). However, each of the succeeding rejections appear to reject the indicated claims over a single reference alone. For example, claims 1-4, 27-35, and 62-70 appear to be rejected as obvious over *Katz* alone. However, as demonstrated more fully below, *Katz* does not teach all of the limitations of these claims. Thus, the Examiner's initial statements make it unclear whether or not the Examiner also intends *Osmani*, *Morgan*, the general knowledge in the art, or even some combination of the three to also be included in the rejection of claims 1-4, 27-35, and 62-70. The Examiner's intended rejection is made even

more ambiguous by the Current Action's concluding request that all references be considered in the Applicants' response.

Because the Applicants do not know which references the Examiner has used to reject the pending claims, it is impossible for the Applicants to identify all of the issues. The Applicants respectfully request that the Examiner either withdraw the pending rejections, or clarify which references have been used to reject which claims.

### **III. The Current Action Fails to Provide the Necessary Support for Rejections Using the Cited References**

The test for non-obvious subject matter is whether the differences between the subject matter and the prior art are such that the claimed subject matter as a whole would have been obvious to a person having ordinary skill in the art to which the subject matter pertains. The United States Supreme Court in Graham v. John Deere and Co., 383 U.S. 1 (1966) set forth the factual inquiries which must be considered in applying the statutory test: (1) determining of the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; (3) resolving the level of ordinary skill in the pertinent art, and (4) evaluating evidence of secondary considerations. See M.P.E.P. §2141.

The M.P.E.P. § 706.02(j), incorporates the mandate of Graham v. John Deere and directs the Examiner to set forth in the Office action: (1) the relevant teachings of the prior art relied upon; (2) the difference or differences in the claim over the applied references; (3) the proposed modification of the applied references necessary to arrive at the claimed subject matter; and (4) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

The Applicants respectfully assert that the Examiner's rejections in the Current Action do not communicate the mandated factual inquiries with respect to the references cited. For example, although the Current Action has used *Katz* to reject claims 1-4, 27-35, and 62-70, it fails to indicate how. In order to comply with the mandates of Graham and the M.P.E.P., the Examiner must indicate which aspects of the rejected claims *Katz* teaches and which aspects of the rejected claims are not taught by *Katz*, where (if at all) the Examiner has found the omitted aspects, and some explanation as to why one of the ordinary

skill in the art would have been motivated to modify *Katz*. Without this information, the Applicants can not properly address the rejection.

The balance of the rejections are similarly flawed, as no details regarding the Examiner's intended use of the cited references are provided. Without these details, the rejections can not meet the requirements of the M.P.E.P., and without these details the Applicants are not provided with a reasonable opportunity to respond. The Applicants, therefore, respectfully ask the Examiner to either withdraw the outstanding rejections or provide the details required.

#### **IV. The Current Action Fails to Establish a Prima Facie Case for Rejection**

Despite the above detailed deficiencies and ambiguities, the Applicants have attempted to respond to what they believe the Examiner intended. However, the rejections the Examiner appears to employ, do not establish a prima facie case of obviousness. The Applicants respectfully remind the Examiner that in order to establish a prima facie case of obviousness, three basic criteria must be met. First, the Examiner must propose a combination of references, or a modification to a single reference, that teaches or suggests each and every limitation of the rejected claims. Second, there must be some suggestion or motivation to combine reference teachings or to modify the reference found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Third, the combination or modification must have inspired a reasonable expectation of success. *See* M.P.E.P. § 2143. Without conceding the third criteria, the Applicants respectfully assert that Current Action fails to demonstrate that proper motivation exists to combine the references proposed, and further assert that even if proper motivation can be found, the potential combinations proposed by the Examiner do not teach all of the limitations of the rejected claims. Therefore, the Applicants respectfully ask the Examiner to withdraw the rejections of claims 1-70.

##### **A. No Motivation Exists for Combining the Proposed References**

The Current Action appears to reject the pending claims through some combination of *Katz*, *Osmani*, and *Morgan*. Although the M.P.E.P. requires the Examiner to provide separate motivation for each intended combination, the Current Action simply states

that “it would have been obvious to one of ordinary skill in the art to combine the teachings of *Katz*, *Morgan*, and *Osmani* in order to obtain greater security with greater efficiency in wireless communication.” In addition to the failure to provide combination specific motivation, the statement that is provided does not adequately describe the requisite motivation. It appears that the Current Action intends *Katz* to be its base reference, and that *Osmani* and *Morgan* are intended to somehow supplement *Katz*’s teachings. However, no indication of which aspects of *Katz* the Examiner believes can be improved, and no indication as to which aspects of *Osmani* or *Morgan* are the source of that improvement is provided. Therefore, the Applicants respectfully assert that Current Action fails to provide motivation for any combination of the cited references, and respectfully ask the Examiner to withdraw the rejections.

**B. The References Cited Do Not Teach or Suggest All of the Limitations of the Rejected Claims**

Even if *Katz*, *Osmani*, and *Morgan* could be combined, however, that combination would fail to teach all of the limitations recited by the rejected claims.

**1. Claim 1**

Claim 1 describes a system for detecting fraud in a prepaid system, that includes:

an interface to said prepaid system, wherein said prepaid system . . . determine[s] a subscriber prepaid balance . . . ;  
an interface to a service system . . . ; and  
control logic . . . to thereby determine a fraud detection subscriber account balance, wherein said control logic utilizes said fraud detection subscriber account balance to determine a fraud condition in an associated subscriber account independent of said determination of said subscriber prepaid balance by said prepaid system.

Accordingly, the system of claim 1, among other things, uses a subscriber’s information account balance and information regarding the types of services provided in order to determine the presence of fraud in a manner that is independent of any determination made by the prepaid system itself. In rejecting claim 1, the Current Action appears to rely on the teachings of *Katz* alone. However, *Katz* teaches a system that facilitates the exchange of purchased telephone minutes by establishing an account that helps normalize the different

values of telephone minutes. The portions cited by the Current Action do not appear to relate to fraud detection at all. Although, mindful of the Examiner's request that Applicants "consider the references in entirety as potentially teaching all or part of the claimed invention," the entirety of *Katz* was reviewed. The Applicants' attorney, however, was unable to locate any aspect of *Katz* that teaches or suggests detecting fraud in a manner independent of fraud determination made by the prepaid system. To the contrary, instead of using independent determinations, the system contemplated by *Katz* integrates associated systems such that a change in the field of one would automatically result in a change in the fields of the other, see column 9 lines 5-25. Therefore, the Applicants respectfully assert that claim 1 is patentable over *Katz*, because, among other things, *Katz* fails to teach the detection of fraud, and any detections *Katz* does teach are not done independently.

As stated above, the Applicants do not know whether or not the Examiner intends to combine the teachings of any other references with *Katz*, but a review by the Applicants' attorney of *Osmani* and *Morgan* could not locate where these references teach or suggest these limitations either.

Claims 2-4 depend either directly or indirectly from claim 1, and also appear to be rejected in view of *Katz* alone. But because the Current Action is unclear which references the Examiner has used to reject these claims, the Applicants' attorney has assumed that the Examiner intends to use all three. Although claims 2-4 do contain further limitations that are absent from any combination of *Katz*, *Osmani*, and *Morgan*, claims 2-4 are at least patentable because claim 1 is patentable, and the Applicants respectfully ask the Examiner to withdraw the rejection.

Therefore, the Applicants respectfully assert that the references cited by the Examiner, do not, whether viewed alone or in combination, teach all of the limitations of claims 1-4, and respectfully ask the Examiner to withdraw the rejections. If the Examiner, in spite of the arguments contained herein, wishes to maintain these rejections, the Applicants respectfully ask that the specifics of those rejections be made more clear in order to provide the Applicants a reasonable opportunity to respond.

## 2. Claim 27

Claim 27 is directed to a method for detecting fraudulent use of a service network associated with a prepaid system that includes:

- interfacing a fraud detection system to said prepaid system, wherein said prepaid system accounts for subscriber account credits and subscriber account debits to thereby determine a subscriber prepaid balance for use of said service network;
- interfacing said fraud detection system to said service network, wherein said service network provides communication subscriber information and generates transaction information associated with communication of said subscriber information;
- accepting prepaid account credit information from said prepaid system at said fraud detection system;
- accepting transaction information from said service network at said fraud detection system;
- determining a service value using accepted transaction information; and
- determining a fraud condition in an associated subscriber account as a function of said accepted prepaid account credit information and said service value determined.

Accordingly, claim 27 is directed to a fraud detection system that, among other things, is able to use transaction information to determine a value for services as they are provided. By also using a subscribers' account balance information, the system can then detect a fraud condition. As with claim 1, the Current Action appears to reject claim 27 over the teachings of *Katz* alone. However, *Katz*, does not appear to teach a system that detects fraud at all. Instead, *Katz* facilitates the exchange of purchased telephone minutes for valuable goods and services by establishing an account that helps normalize the different values of telephone minutes. A review by Applicants' attorney was unable to locate any aspect of *Katz* that teaches or suggests detecting fraud by determining a value for services as they are provided and interfacing with a prepaid system to acquire account balance information. Thus, the Applicants respectfully assert that *Katz* does not teach all of the limitations of claim 27, and respectfully ask the Examiner to withdraw the rejection.

As with claim 1, the Applicants do not know whether or not the Examiner intends to combine the teachings of any other references with *Katz* in rejecting claim 27, but a review by the Applicants' attorney of *Osmani* and *Morgan* could not locate where these references teach or suggest the limitations of claim 27 that are absent from *Katz*.

Claims 28-35 depend either directly or indirectly from claim 27, and also appear to be rejected in view of *Katz* alone. But because the Current Action is unclear which references the Examiner has used to reject these claims, the Applicants' attorney has assumed that the Examiner intends to use some combination of the three. Although claims 28-35 do contain further limitations that are not taught by any combination of *Katz*, *Osmani*, and *Morgan*, claims 28-35 are at least patentable because claim 27 is patentable, and the Applicants respectfully ask the Examiner to withdraw the rejection.

Therefore, the Applicants respectfully assert that no combination of the references cited by the Examiner teach all of the limitations of claims 27-35, and respectfully ask the Examiner to withdraw the rejections. If the Examiner, in spite of the arguments contained herein, maintains these rejections, the Applicants respectfully ask that the Examiner to identify the specifics more clearly in order to provide the Applicants a reasonable opportunity to respond.

### 3. Claim 62

Claim 62 is directed to a method for detecting fraudulent use of a telephone network that includes:

- selecting a fraud threshold value . . . ;
- accepting prepaid account credit information from said prepaid calling system . . . substantially at the completion of interaction between said prepaid calling system and said subscriber;
- accepting subscriber call information from said telephone network at said call data record server . . . substantially at the completion of an associated call;
- determining a value of a subscriber call using said subscriber call information;
- determining a call data server subscriber account balance . . . ;
- comparing said determined call data server subscriber account balance; and
- determining if an unacceptable level of fraud is associated with a particular subscriber prepaid account as a function of said comparison.

Accordingly, the method of claim 62, among other things, determines fraud by comparing a subscriber's account balance to a determined value of the service being provided. As with claims 1 and 27, the Current Action appears to reject claim 62 over the

teachings of *Katz* alone. However, *Katz*, does not appear to teach a system that detects fraud at all. Instead, *Katz* facilitates the exchange of purchased telephone minutes for valuable goods and services by establishing an account that helps normalize the different values of telephone minutes. A review by Applicants' attorney of *Katz* in its entirety was unable to locate any aspect of *Katz* that teaches or suggests detecting fraud by comparing a subscriber's account balance to a determined value of the service being provided. Thus, the Applicants respectfully assert that claim 62 is patentable over *Katz*.

The Applicants are again unsure whether or not the Examiner intends to combine the teachings of any other references with *Katz* in rejecting claim 62, but a review by the Applicants' attorney of *Osmani* and *Morgan* could not locate where these references teach or suggest the limitations missing from the teachings of *Katz*.

Claims 63-70 depend either directly or indirectly from claim 62, and also appear to be rejected in view of *Katz* alone. But because the Current Action is unclear which references the Examiner has used to reject these claims, the Applicants' attorney has assumed that the Examiner intends to use all three. Although claims 63-70 do contain further limitations that are not taught by any combination of *Katz*, *Osmani*, and *Morgan*, claims 63-70 are at least patentable because claim 62 is patentable, and the Applicants respectfully ask the Examiner to withdraw the rejection.

Therefore, the Applicants respectfully assert that the references cited by the Examiner, do not, whether viewed alone or in combination, teach all of the limitations of claims 62-70, and respectfully ask the Examiner to withdraw the rejections. If the Examiner, in spite of the arguments contained herein, maintains these rejections, the Applicants respectfully ask that the Examiner to identify the specifics more clearly in order to provide the Applicants a reasonable opportunity to respond.

#### 4. Additional Dependent Claims

Dependent claims 4-20 and 36-58 depend either directly or indirectly from independent claims 1 and 27 respectfully, but appear to be rejected as obvious in light of *Osmani* alone. Because *Katz* is used in the rejection of claims 1 and 27, the Applicants assume that it is a combination of *Katz* and *Osmani* that the Examiner intended to use.



Although claims 4-20 and 36-58 also contain further limitations not found in this combination, claims 4-20 and 36-58 are patentable over the combination of *Katz* and *Osmani*, at least, because claims 1 and 27 are patentable. Therefore, the Applicants respectfully ask the Examiner to withdraw the rejection.

Dependent claims 21-26 and 59-61 also depend either directly or indirectly from independent claims 1 and 27 respectfully, but appear to be rejected as obvious in light of *Morgan* alone. Because *Katz* is used in the rejection of claims 1 and 27, the Applicants assume that it is a combination of *Katz* and *Morgan* that the Examiner intended to use. Although claims 21-26 and 59-61 also contain further limitations not found in this combination, claims 21-26 and 59-61 are patentable over the combination of *Katz* and *Osmani*, at least, because claims 1 and 27 are patentable. Therefore, the Applicants respectfully ask the Examiner to withdraw the rejection.

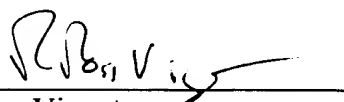
#### V. Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 47524/P120US/10023619 from which the undersigned is authorized to draw.

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Respectfully submitted,

By   
R. Ross Viguet  
Registration No.: 42,203  
FULBRIGHT & JAWORSKI L.L.P.  
2200 Ross Avenue, Suite 2800  
Dallas, Texas 75201-2784  
(214) 855-8000  
(214) 855-8200 (Fax)  
Attorney for Applicant